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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,017	12/04/2003	Eric Lawrence Barsness	ROC920030312US1	7311
30206	7590	08/29/2006	EXAMINER	
IBM CORPORATION ROCHESTER IP LAW DEPT. 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			KIMBALL, MAKAYLA T	
			ART UNIT	PAPER NUMBER
			2194	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/728,017

Applicant(s)

BARSNESS ET AL.

Examiner

Makayla Kimball

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) \*
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-20 are pending and are considered below.

#### ***Specification***

1. The disclosure is objected to because of the following informalities: On page 9: line 19, "a paste option 215" is numbered wrong.

Appropriate correction is required.

#### ***Claim Objections***

2. Claim 17 is objected to because of the following informalities: commas after each sentence should be semicolons; and "plurality or values" should be "plurality of values".

Appropriate correction is required.

#### ***Double Patenting***

3. Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 18. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 1-20 rejected under 35 U.S.C. 101. Claims 1, 8, 13 and 17 are rejected under 101 because if-else statement is not complete. Applicant does not specify what would happen when the block of code is less than the threshold. Claims 2-7, 9-12, 14-16 and 18-20 are being rejected under 35 U.S.C. 101 as being dependent upon independent claims 1, 8, 13 and 17, respectively.

Claims 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be nonstatutory because in the description on pages 8 and 9, that the signal-bearing medium includes a signal or propagation.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-3, 8, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al (US Patent 6072951) in view of Narisawa et al (US Patent 6851106).

9. Examiner's Note. The applicant appears to be attempting to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in claims 8-12 by using "means-plus-function" language. However, the examiner

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notes that the only "means" for performing these cited functions in the specification appears to be software. While the claim passes the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6<sup>th</sup> paragraph has not been invoked when considering these claims below.

Claim 1:

Donovan discloses a method for comparing code size to a threshold [Column 9, lines 53-55]. However, Donovan does not disclose generating code when the size is greater than a threshold. In the same field of endeavor, Narisawa does disclose generating code [Column 6, lines 16-21]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate generating code into Donovan, since Donovan already discloses code manipulation based on threshold comparison [Column 9, lines 53-55]. And without the comparison of the threshold resulting output code will need a large memory capacity capable of implementing to avoid page faults. One would have been motivated to incorporate generation of code in order to allow the optimization of program code. The optimization of program code enables executing the information processing in a shorter time and reducing memory usage in executing the information processing.

For the purpose of examining, claims 2, 8, "Replacing...with an invocation of the method" and claims 3, 9 "Adding an invocation of the method..." will be interpreted as "calling a procedure".

Claim 2:

The method of claim 1, further comprising:

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Replacing the block of code at a copy location with an invocation of the method [Donovan, Column 2, lines 33-35].

Claim 3:

The method of claim 1, further comprising:

Adding an invocation of the method at a paste location [Donovan, Column 2, lines 33-35].

Claim 8:

Donovan discloses an apparatus for comparing code size to a threshold [Column 9, lines 53-55]. Donovan also discloses an apparatus for replacing the block of code with an invocation of the method [Column 2, lines 33-35]. However, Donovan does not disclose generating code when the size is greater than a threshold. In the same field of endeavor, Narisawa does disclose generating code [Column 6, lines 16-21]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate generating code into Donovan, since Donovan already discloses code manipulation based on threshold comparison [Column 9, lines 53-55]. And without the comparison of the threshold resulting output code will need a large memory capacity capable of implementing to avoid page faults. One would have been motivated to incorporate generation of code in order to allow the optimization of program code. The optimization of program code enables executing the information processing in a shorter time and reducing memory usage in executing the information processing.

Claim 9:

The apparatus of claim 8, further comprising:

Means for adding the invocation of the method at a paste location [Donovan, Column 2, lines 33-35].

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For the purpose of examining, claim 13, "Replacing...with an invocation of the method" and "adding an invocation of the method..." will be interpreted as "calling a procedure".

Claim 13:

Donovan discloses a signal-bearing medium for comparing code size to a threshold [Column 9, lines 53-55]. Donovan also discloses replacing the block of code with an invocation of the method [Column 2, lines 33-35] and adding the invocation of the method at a paste location [Column 2, lines 33-35]. However, Donovan does not disclose generating code when the size is greater than a threshold. In the same field of endeavor, Narisawa does disclose generating code [Column 6, lines 16-21]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate generating code into Donovan, since Donovan already discloses code manipulation based on threshold comparison [Column 9, lines 53-55]. And without the comparison of the threshold resulting output code becomes will need a large memory capacity capable of implementing to avoid page faults. One would have been motivated to incorporate generation of code in order to allow the optimization of program code. The optimization of program code enables executing the information processing in a shorter time and reducing memory usage in executing the information processing.

10. Claims 4-7, 10-12, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al (US Patent 6072951) in view of Narisawa et al (US Patent 6851106) as applied to claim 1 above, and further in view of Hiew et al (PGPUB 2005/0229154).

For the purpose of examining, claims 4, 5, 10-12, 14-16 and 18-20 where "part(s)", "class" and "package(s)" are claimed, they will be interpreted as "template(s)"

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For the purpose of examining claim 7 where a punch-out operation is claimed, punch-out will be interpreted as "cut and paste".

Claims 4-7:

Donovan and Narisawa disclose the method in claim 1 above. However, Donovan and Narisawa do not disclose displaying user interface options when operation is performed within a single part and class nor do they disclose displaying user interface options when the operation is performed between two parts in a single package. Donovan and Narisawa also do not disclose copy and paste operation nor a punch-out operation. In the same field of endeavor, Hiew does disclose displaying user interface options [Figure 4d; 0044, "display area...menu items included on the menu bar...associated with those options."] when the operation is performed within a single part and class [0009, 0054] and when the operation is performed between two parts in a single package [0009, 0054]. Hiew also discloses copy and paste operation [Figure 4b and 4f] and a punch-out operation [Figure 4b and 4f]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate user interface options into Donovan, since Donovan already discloses screen displays to inform the user. And having user interface options available one would know other possible choices that are available. One would have been motivated to incorporate displaying user interface options in order to make choices on how to manipulate the code.

Claims 10-12:

Donovan and Narisawa disclose the apparatus in claim 8 above. However, Donovan and Narisawa do not disclose selecting user interface options when operation is performed within a single part and class neither do they disclose selecting user interface options when the operation is performed between two parts in a single package nor do they disclose selecting user interface options when the operation is performed between two parts in two different



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packages. In the same field of endeavor, Hiew does disclose selecting user interface options [Figure 4d; 0044, "display area...menu items included on the menu bar...associated with those options."] when the operation is performed within a single part and class [0009, 0054], when the operation is performed between two parts in a single package [0009, 0054], and when the operation is performed between two parts in two different packages [0009, 0054]. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate user interface options into Donovan, since Donovan already discloses screen displays to inform the user. And having user interface options available one would know other possible choices that are available. One would have been motivated to incorporate displaying user interface options in order to make choices on how to manipulate the code.

Claims 14-16:

Claims 14-16 are rejected on the same basis as claims 10-12.

For the purpose of examining, claim 17, "Replacing...with an invocation of the method" and "adding an invocation of the method..." will be interpreted as "calling a procedure".

Claim 17:

Donovan discloses an electronic device with a processor [Figure 1] and a storage device [Figure 1]. Donovan also discloses replacing the block of code with an invocation of the method [Column 2, lines 33-35] and adding the invocation of the method at a paste location [Column 2, lines 33-35]. Donovan also discloses comparing code size to a threshold [Column 9, lines 53-55]. However, Donovan does not disclose generating code when the size is greater than a threshold. In the same field of endeavor, Narisawa does disclose generating code [Column 6, lines 16-21]. In addition, Donovan does not disclose a helper class. In the same field of endeavor, Hiew does disclose a help feature [Figure 4e]. Therefore, it would have been obvious

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to a person of ordinary skill in the art at the time the invention was made to incorporate generating code and a help function into Donovan, since Donovan already discloses code manipulation based on threshold comparison [Column 9, lines 53-55]. And without the comparison of the threshold resulting output code will need a large memory capacity capable of implementing to avoid page faults. One would have been motivated to incorporate generation of code in order to allow the optimization of program code. The optimization of program code enables executing the information processing in a shorter time and reducing memory usage in executing the information processing. And, with the help feature, if one has questions that need to be answered, a help feature will help.

Claims 18-20:

Claims 18-20 are rejected on the same basis as claims 10-12.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sells et al (US PG PUB 2002/0184609) – discloses a method and apparatus for producing software.

Pokhariyal (US PG PUB 2003/0204833) – discloses a method for a procedure call.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Makayla Kimball whose telephone number is 571-270-1057. The examiner can normally be reached on Monday - Thursday 10AM - 3PM EST.

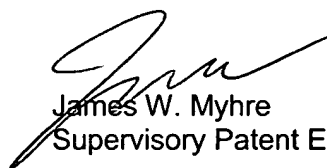
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Myhre James can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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08/09/2006



James W. Myhre  
Supervisory Patent Examiner